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EXAMINER
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LANG, AMY T

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3731

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-33** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claims 1 recites wherein the metalworking fluid comprises at least one additive package "having synergistic combination of various additive components such as..." Therefore, it is the examiner's position that it is unclear as to whether the additive package must contain the listed ingredients or if the ingredients merely represent examples of additive components. The instant claim 1 does not positively recite the listed ingredients as part of the additive package. Additionally, it is also the examiner's position as to what ingredients are included in the additive package. The claims seem to refer to only the lubricity booster, antioxidant, fungicide, extreme pressure agent, and anti rust agent as components of the additive package and the alkyl benzene, emulsifier, co-surfactant, coupling agent, and alkali earth metal salt as separate and distinct main ingredients that are not part of the additive package. However, the remarks filed 01/18/2008 refer to only three main ingredients: alkyl benzene, emulsifier, and additives (page 1, lines 15-16), which seems to teach that all the ingredients except the alkyl benzene and emulsifier are part of the additive package. Therefore the claims

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by themselves are unclear and a discrepancy exists between the instant claims and remarks.

(ii) Claim 1 recites wherein the "composition is useful as general purpose soluble cutting oil by obtaining emulsion by stirring it in water 60 to 90 weight percent, which act as a coolant/engineering aid in metalworking having less toxicity than mineral oil and value-addition to heavy alkyl benzene, a waste product." However, it is the examiner's position that this phrasing is confusing and unclear. First of all, is the fluid useful as a general purpose soluble cutting oil when an emulsion is obtained after the fluid is stirred with water? Does the water act as a coolant/engineering aid in metalworking fluids? What does the term value-addition refer to? Lastly, is a waste product being positively claimed or does it refer to the alkyl benzene?

Claims 2-33 are dependent upon claim 1 and therefore are also rendered indefinite.

3. **Claim 1** recites the limitation "the composition" in 17. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Eckard (US 6,225,267 B1).

Eckard discloses a metalworking fluid comprising an alkyl benzene and a sulfonate emulsifier (column 1, lines 16-20). The alkyl benzene is further disclosed as having a C<sub>8</sub>-C<sub>30</sub> alkyl and comprising 5 to 50 wt% of the metalworking fluid (column 4, lines 35-49). The sulfonate emulsifier is present in the fluid from 10 to 70 wt% which clearly overlaps the instant claims (column 3, lines 62-67). Eckard also discloses various additives in the composition including an extreme pressure agent, a bactericidal (fungicide), and other well known additives (column 6, lines 29-40). Therefore, Eckard discloses a metalworking fluid comprising an alkyl benzene, a sulfonate emulsifier, and an additive package having a synergistic combination of various components.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. **Claims 1-12 and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Anantaneni (US 6,630,430) in view of Boffa (US 5,804,537), Tanaka (US 6,245,725 B1), Camenzind (US 7,026,438 B2), Van Dam (US 6,784,142 B2), Matsushita (US 5,741,763), Zoch (US 3,902,868), and Otaki (US 4,765,917).

Anantaneni discloses a lubricating composition for a metal surface, specifically an internal combustion engine (column 1, lines 14-19; claim 39, column 38). The composition is comprised of alkyl benzenes, having 18 to 30 carbon atoms, to enhance detergency (column 1, lines 20-25, 55-58). The alkyl benzenes are present in the lubricating composition from 35 to 82 wt% of the total composition (claim 1, column 32). Anantaneni teaches the method to produce the alkyl benzenes useful in the lubricant composition, which results in a fraction by-product separated from detergent class alkyl benzene (column 3, lines 19-43). Furthermore, Anantaneni discloses the use of additives in the composition including extreme pressure additives, antioxidants, and more (column 21, lines 38-45).

Anantaneni does not specifically disclose the addition of (i) an emulsifier, (ii) a lubricity booster, (iii) an antioxidant, (iv) an antirust agent, (v) a coupling agent, (vi) a fungicide, (vii) an extreme pressure additive, (viii) a co-surfactant, (ix) an alkali component, or (x) the composition suitable for use as general emulsion as admixture with water.

With respect to (i) above, Boffa discloses a lubricating composition for an internal combustion engine comprised of alkylated sodium sulfonates from 5 to 80 wt% (column

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1, lines 6-10; column 4, lines 15-21; column 5, lines 18-21). This additive aids in producing superior engine deposit performance (column 3, lines 16-21). Although Boffa does not specifically disclose the alkylated sodium sulfonates additive as an emulsifier, given that the property of a compound is inseparable from the compound, it therefore would intrinsically function as one in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a lubricating composition for an internal combustion engine and Boffa discloses that sodium sulfonate additives are advantageous in engine deposit performance, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (ii) above, Tanaka discloses that additives are added to engine lubricating oils in order to reduce frictional losses (column 1, lines 30-34). One such additive is castor oil in an amount of 0.05 to 10 wt% (column 18, lines 28-30, 38; column 19, lines 16-19). Although Tanaka does not specifically disclose the castor oil additive as a lubricity booster, given that the property of a compound is inseparable from the compound, it would intrinsically function as one in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a lubricating composition for an internal combustion engine and Tanaka discloses that additives including castor oil reduce frictional losses in an engine, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (iii), (iv), and (v) above, Camenzind discloses a lubricating composition, specifically metal working fluid, comprised of additives to further improve performance properties (column 7, lines 60-66). The additives include the antioxidant

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diphenylamine, calcium petroleum sulphonates, and petroleum sulfonates each in an amount from 0.01 to 10.0 wt% (column 8, lines 2-5; column 10, line 10; column 11, lines 29 and 60). Although Camenzind does not specifically disclose the calcium petroleum sulphonates as antirust agents or the petroleum sulfonates as coupling agents, given that the property of a compound is inseparable from the compound, they would intrinsically function as such in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a metal working fluid and Camenzind teaches the advantage of using these additives, it would have been obvious for Anantaneni to also utilize these additives.

With respect to (vi) above, Van Dam discloses a lubricating composition for an internal combustion engine comprised of specific additives (column 2, lines 48-59). The additives include a hindered phenol, which overlaps the instantly claimed phenol, from 0 to about 2.0 wt% (column 5, lines 28-31). The phenol additive aids in lowering water deposits in engines, improving dispersion of soot in engines, and controlling wear and valve train wear (column 2, lines 52-59). Although Van Dam does not specifically disclose the phenol additive as a fungicide, given that the property of a compound is inseparable from the compound, it would intrinsically function as such in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a lubricating composition for an internal combustion engine and Van dam teaches the advantage of a phenol additive in an internal combustion engine, it would have been obvious for Anantaneni to also utilize this additive.



With respect to (vii) above, Matsushita discloses a metal working lubricant comprised of additives conventionally used in lubricant oils (column 1, lines 13-23; column 4, lines 16-22). One of these conventional additives is specifically disclosed as diphenyl disulfide in an amount from 0.01 to 5 wt% (column 4, lines 30, 51-53). Although Matsushita does not specifically disclose the additive as an extreme pressure agent, given that the property of a compound is inseparable from the compound, it would intrinsically function as such in a lubricating composition (*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)). Since Anantaneni discloses a metal working fluid comprised of an extreme pressure agent and Matsushita discloses that diphenyl disulfide is a conventional additive in the lubricant art, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (viii) above, Zoch discloses a fuel composition utilized in internal combustion engines (column 1, lines 6-7). The composition is comprised of specific additives that provide increased combustion efficiency, reduced gaseous pollutant emissions, and reduced volatility of the fuel additive (column 1, lines 44-49). One such additive is disclosed as isopropanol from 10 to 20 wt% (column 2, lines 16-25). Since Anantaneni discloses a lubricating composition for an internal combustion engine that can be utilized in fuels (column 31, lines 57-65), and Zoch discloses the advantage of an isopropanol additive to a fuel composition, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (ix) above, Otaki discloses a lubricant composition for use in high temperature applications (column 1, line 66 through column 2, line 3). One extreme

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pressure additive is specifically disclosed as calcium carbonate, which clearly overlaps the instantly claimed alkali metal component, in an amount from 1 to about 16 wt% (column 2, lines 25-29; column 3, lines 56-60). This additive is selected since it can function under extremely high pressure conditions (column 3, lines 60-62). Therefore, since Anantaneni discloses a lubricating composition comprised of extreme pressure agents for an internal combustion engine, a high temperature environment, and Otaki discloses a specific extreme pressure agent for a high temperature environment, it would have been obvious for Anantaneni to also utilize this additive.

With respect to (x) above, given that the combination of the above cited references leads to the claimed composition as explained above, it therefore would have been obvious that the composition taught by the combination of references would intrinsically have been suitable for use as general emulsion in admixture with water.

### ***Response to Arguments***

9. Applicant's arguments, filed 01/18/2008, with respect to 35 USC 112 rejection of enablement have been fully considered and are persuasive. The rejection has been withdrawn.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §

706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Lang whose telephone number is (571) 272-9057. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

05/05/2008

/Amy T Lang/

Examiner, Art Unit 3731

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3731